



AF/1700

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re patent application of Leon P. Janik et al

Examiner: Cecil, Terry K.

Serial No.: 09/7785,785

Group Art Unit: 1723

Filing Date: 02/16/2001

For: Multi-Configurable Filter Base Module and Manufacturing Method Therefor

Box AF
Commissioner for Patents
Washington, DC 20231

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FEB 27 2003
TC 1700

Sir:

Transmitted herewith is an amendment in the above-identified application.


- () A small entity statement was previously submitted in this application.
() A small entity statement is enclosed.
(XX) A filing fee for extra claims does not appear required.
() A filing fee for extra claims is calculated below:

No. of Claims Remaining After Amendment	Highest No. of Claims Previously Paid For	No. of Extra Claims	Fee For Small Entity		Fee For Other Than Small Entity	
			Rate	Fee	Rate	Fee
Total		0	x \$ 9 = \$		x \$ 18 = \$	
Indep.		0	x \$ 42 = \$		x \$ 84 = \$	
() First Presentation of Multiple Dependent Claims			+ \$ 140 = \$		+ \$ 280 = \$	
			TOTAL = \$		TOTAL = \$	

(XX) It is hereby petitioned that any required extension of time be granted for filing the amendment. An extension of ____ month(s) having a fee of \$ ____ appears required.

() A check in the amount of \$ ____ is attached. Please credit any overpayment to Deposit Account 16-2563 of Alix, Yale & Ristas, LLP.

The Commissioner is hereby requested and authorized to charge Deposit Account 16-2563 of Alix, Yale & Ristas, LLP, for any fee, not enclosed herewith, due for any reason in connection with the amendment or this or any other document accompanying the amendment, including (a) any filing fees under 37 CFR 1.16 for the presentation of extra claims and (b) any patent application processing fees under 37 CFR 1.17. A duplicate copy of this sheet is attached.


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I hereby certify that this correspondence is being deposited on the date below with the United States Postal Service as first class mail in an envelope addressed to "Commissioner for Patents, Washington, DC 20231."

Signature: 
Guy D. Yale

Reg. No. 29,125

Date February 21, 2003



Attorney Docket No.: STAN/322/US

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Serial No.: 09/785,785

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Sir:

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3.6.03

RESPONSE TO OFFICIAL ACTION UNDER 37 C.F.R. §1.116

In response to the Final Rejection mailed December 26, 2002, Applicants request entry and consideration of the following request, amendment and remarks.

Request to Withdraw Final Rejection and Consider the Enclosed Response

This Request is necessitated by the following:

1. Examiner Revis, who issued the first Office Action, and Examiner Cecil, who issued the Final Rejection, clearly interpreted the claims in an inconsistent manner and thus the "Final" Rejection is premature.
2. The "Final Rejection" does not comport with the requirements for a final action.

The Examiner's attention is respectfully directed to the following passages from the MPEP laying out the standards applicable to a final rejection:

37 C.F.R. §1.104 Nature of Examination

(a) Examiner's action. (1) On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated. (emphasis added)

MPEP §706.07 Final Rejection

Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied...

The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her case... The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal ...

In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. They must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection...

37 C.F.R. §1.113 Final rejection or action.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the case, clearly stating the reasons therefor.

Basis for Request to Withdraw Final Rejection

The first and second (final) rejections of Applicants' claims fail to meet the statutory and regulatory standards governing patent examination. Applicants addressed the deficiencies of the first rejection (made by Examiner Revis) in a detailed response to office action filed June 28, 2002. The second office action (mailed December 26, 2002) was made final by Examiner Cecil without fully addressing Applicants' arguments or the deficiencies of the prior rejection under 35 U.S.C. §§ 102 and 103.

The current office action is incomplete. In particular, Examiner Cecil did not address Applicants' arguments with respect to claims 21-28 in any way.

The final rejection of claims 1-20 repeats the logical flaws of the prior rejection, impermissibly ignores the plain meaning of the claim terms, and fails to provide a *prima facie* case of anticipation or obviousness for each of claims 1-28.

A final rejection that fails to comply with all relevant rules and regulations imposes an undue burden on the Applicants. Non-compliant rejections that are made final unfairly restrict the Applicants' ability to respond because the issues of patentability are not adequately developed in accordance with the standards expressed in the MPEP, 37 C.F.R and 35 U.S.C. Applicants presented with a non-compliant final rejection are unable to judge the advisability of an appeal because the office action does not contain a complete statement supporting the rejection. A non-compliant final rejection also prematurely cuts off the prosecution without giving the Applicants a full and fair hearing.

For all the foregoing reasons, Applicants respectfully request consideration of the following amendment and remarks. Should the Examiner find Applicants' response insufficient to overcome the